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REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 59-71 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,846,241 to Kittur et al., (hereinafter "Kittur").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, independent claims 59 and 65 have been amended to clarify their distinguishing features.

Kittur discloses a bipolar electrocautery device (10). To be more specific, in the device of Kittur, a fixed electrode (14) at the tip end of the cylindrical main body member (12) is necessarily located opposite to a second electrode (24) provided at a movable head (22). Thus, when the device is used, the movable head is moved forwards and backwards relative to the fixed electrode 14. Tissue to be cauterized must be present between and contacting both the fixed and second electrodes such that the cauterizing current flows from one of the electrodes to the other.

With regard to independent claim 59, the same has been amended to clarify that the same is directed to a monopolar device where the tip end portion of the cylindrical main body member has electrically insulating properties and where the electrode faces the tip end portion of the main body member. This is in stark contrast to the bipolar device of Kittur having two electrodes facing each other in electrical cooperation, one of which being disposed at the tip end portion of the cylindrical main body member.

The amendment to claim 59 is fully supported in the original disclosure. Thus no new matter has been entered into the disclosure by way of the present amendment to claim 59.

With regard to claim 65, the same has been amended to clarify that the same is of a bipolar configuration having a first electrode and a member connected to the first electrode, where the member has a second electrode including a tip end which is spaced apart from a base-end surface of the first electrode and an insulating portion located between the tip end of the second electrode and the base-end surface of the first electrode to electrically isolate the first and second electrodes. Dependent claims 66-71 have also been amended to be consistent with amended claim 65 from which they depend. The amendment to claim 65 is fully supported in the original disclosure. Thus no new matter has been entered into the disclosure by way of the present amendment to claim 65.

Although the diathermic cutter of claim 65 and the electrocautery device 10 of Kittur are both bipolar, the elongated member (20) of Kittur merely provides a current to flow to the moving electrode (24). That is, Kittur does not disclose an elongated member having a second electrode and an insulating portion configured as recited in claim 65.

In the Official Action, the Examiner argues that the rearrangement of the parts of Kittur is obvious and the motivation for such is held in In re Peterson 315 F.3d 1325 at 1330 (Fed. Cir. 2003).

Firstly, Applicants have amended claims 59 and 65 as discussed above to clarify the structural differences between the two which is not a mere rearrangement of parts but a novel combination of the recited elements.

Secondly, Applicants know of no holding of authority which states that a rearrangement of parts is obvious per se. In re Peterson holds that for a chemical composition (such as an alloy), if the prior art discloses a range of percentages for a given component of the composition, than any invention claiming an overlap in that range is obvious. In re Peterson has nothing to do with a rearrangement in parts of a physical structure and cannot be interpreted in such a manner. Furthermore, in In re Japikse, 181 F.2d 1019 (CCPA 1950) cited by the Examiner, the same holds that a shifting of a position of a switch from one position to another on the same machine was an obvious variation of the prior art because the different position of the switch would not have modified the operation of the device. As discussed in previous response, the different (and patentably distinguishing) configuration of the diathermic cutters of claims 59 and 65 are used in different ways than that of the valvulotome of Kittur. Thus, In re Japikse is also inapplicable to the current application.

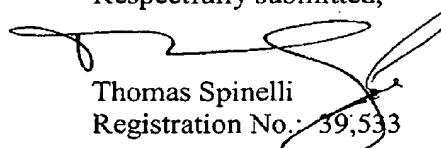
Thus, independent claims 59 and 65 are not rendered obvious by the cited references because the Kittur patent, whether or not taken in combination with the knowledge of those of ordinary skill in the art, does not teach or suggest a diathermic cutter having the features discussed above and recited in independent claims 59 and 65. Accordingly, claims 59 and 65 patentably distinguish over the prior art and are allowable. Claims 60-64 and 66-71, being dependent upon claims 59 and 65, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 59-71 under 35 U.S.C. § 103(a).

Lastly, claim 70 has been amended to correct an error therein. Specifically, "main bar" has been changed to --member-- to be consistent with its base claim (65). As

such, no new matter has been introduced into the original disclosure by way of the amendment to claim 70.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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